

12-29-05

AF
21/11

"EXPRESS MAIL" MAILING LABEL NO. EV361224760US

DATE OF DEPOSIT: December 27, 2005

I HEREBY CERTIFY THAT THIS PAPER OR FEE IS BEING
DEPOSITED WITH THE UNITED STATES POSTAL SERVICE
"EXPRESS MAIL POST OFFICE TO ADDRESSEE" SERVICE UNDER
37 C.F.R. 1.10 ON THE DATE INDICATED ABOVE AND IS
ADDRESSED TO THE COMMISSIONER OF PATENTS, P.O. BOX
1450, ALEXANDRIA, VIRGINIA 22313-1450

Lisa M. Tinnirella

(TYPED NAME OF PERSON MAILING PAPER OR FEE)

Lisa M. Tinnirella

(SIGNATURE OF PERSON MAILING PAPER OR FEE)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the Application of:

RICHARD L. PALINKAS

Title: SIDE BEARING PAD

Serial No.: 09/407,053

Filed: September 27, 1999

)
)
) Examiner: B. Pezzlo
)
) Group Art Unit: 3683
)
)
) (Our Docket No. 6350-05)

Mail Stop AF
COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, VA 22313-1450

SUPPLEMENTAL APPEAL BRIEF

Dear Sir:

This appeal is taken from the Final Office Action mailed December 21, 2004 in the above-identified application. The present Supplemental Appeal Brief is substantially the same as the Appeal Brief filed on May 5, 2005, in the above-identified application, with the addition of evidence appendix at Paragraph IX and a Related Proceeding Appendix at Paragraph X in accordance with 37 C.F.R. § 41.37(c)(1).

I. Real Party in Interest

The real party in interest with respect to the above-identified patent application is: Uniroyal Chemical Company, Inc., located at World Headquarters, Middlebury, Connecticut 06749.

II. Related Appeals and Interferences

In Appeal No. 2004-1395 decided June 22, 2004, the Board reversed the Examiner's final rejection of the claims of the above-identified application. A copy of the Board's Decision is attached hereto as Exhibit A.

Following the above-identified Appeal, the Examiner initiated an additional search and has again finally rejected Applicant's claims thereby necessitating the present Appeal.

III. Status of Claims

Claims 1, 3, 5, 6, 8, 10-15, 17 and 19-24 are pending in the application and stand rejected by the Examiner. All rejected claims are presented to the Board for reconsideration.

IV. Status of Amendments

The amendment filed October 26, 2004 has been entered per the Advisory Action dated February 8, 2005.

V. Summary of Claimed Subject Matter

Independent claim 15 of the present invention is directed to a bearing pad assembly including a first housing having a bore extending therethrough, and a first load bearing member coupled to the first housing and defining an abutment surface opposite the first housing. A second housing also having a bore extending through the second housing is adapted to telescopically receive the first housing. A second load bearing member is coupled to the second housing opposite the second abutment surface. Claim 15 further recites a least one compression spring in the shape of a torus positioned within the first housing bore. (Spec., p. 4, l. 28 – p. 5, l. 33).

Claim 1, also independent, includes all of the recitation of claim 15 and further recites a slip lining positioned between an exterior surface of the first housing and a bore wall defining the bore of the second housing. Further claim 1 recites that the compression spring comprises a solid resilient material having a torus shape. (Spec., p. 5, ll. 5-29; p. 3, ll. 17-19).

VI. Grounds of Rejection to be Reviewed on Appeal

Appellants request the Board to review the following grounds for rejection asserted by the Examiner.

- A. Claim 15 has been rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Pat. No. 4,566,678 to Anderson (hereinafter referred to as "Anderson").
- B. Claim 1 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Anderson in view of U.S. Patent No. 4,465,799 to Platkiewicz et al. (hereinafter referred to as "Platkiewicz"), in view of U.S. Patent No. 5,036,774 to Curtis et al. (hereinafter referred to as "Curtis") and in view of U.S. Patent No. 5,086,707 to Spencer et al. (hereinafter referred to as "Spencer").

VII. Argument

A. Claim 15 is not anticipated under 35 U.S.C. §102(b) by the Anderson reference, namely, U.S. Patent No. 4,566,678.

ISSUE ON APPEAL: Whether the Patent Examiner can impose a broader definition for the claim term "torus" so that the claim reads on the Anderson reference when Appellant has expressly adopted a more limited dictionary definition for the claim term so as to distinguish the claimed invention over Anderson.

Claims 15 was rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Pat. No. 4,566,678 to Anderson (hereinafter referred to as "Anderson") in the Office Action dated September 15, 2004.

Anderson discloses a method of making useful hollow bodies from a block of thermoplastic elastomer material having a selected initial axial height and an axial core opening. The method includes applying an axial force to the block sufficient to compress the block a substantial extent to reduce the free height of the block and expand the axial core opening transversely outwardly for defining sidewalls of the hollow elastomer body to be produced. The axial force is then removed, and the resulting hollow elastomer body is prepared for use as a compression spring or other useful device. (Anderson, abstract, p. 1). Anderson further discloses that the shape of the hollow elastomer body produced in accordance with the Anderson method, can be cylindrical, oval, generally rectangular, or square in configuration. (Anderson, col. 2, ll. 36-37).

Anderson does not disclose a compression spring in the shape of a torus. Further, the method of manufacturing the compression springs of Anderson includes compressing elastomer blocks using compression jigs such as the plates P in Figure 3 and the jaws J shown in Figure 5 of Anderson. (Anderson, col. 4, ll. 20-24; col. 5, l. 66 - col. 6, l. 15). The compression jigs disclosed in Anderson are not capable of producing a torus shaped compression spring.

In response to the Examiner's rejection under 35 U.S.C. § 102(b) over Anderson, Appellant amended claim 15 to replace the term "toroid" with "torus" which was intended to further limit the scope of the claim and distinguish the claimed invention over Anderson. (See, Response to Office Action filed October 21, 2004). As defined in Merriam-Webster's Third New International Dictionary the word "torus" is defined as "a surface or solid shaped like a doughnut and formed by revolving a circle about a line in its plane without intersecting it." (See Exhibit B attached hereto). Whereas, the word "toroid" as defined in Merriam-Webster's Third New International Dictionary means, "a surface generated by the rotation of a plane closed curve about an axis lying in its plane and not intersecting it." (See Exhibit C attached hereto).

In the above-identified Response, Appellant expressly adopted the above-identified dictionary definition for the word "torus" for the purpose of the present application. Thus, pending claim 15 recites a bearing pad assembly comprising, *inter alia*, at least one compression spring positioned within the first housing bore, the compression spring comprising a solid resilient material having a torus shape. The

term torus describing a surface or solid shaped like a doughnut and formed by revolving a circle about a line in its plane without intersecting it. Accordingly, Appellant has adopted a dictionary definition, which complies with the presumption that a claim term carries its ordinary and customary meaning. CCS Fitness, Inc. v. Brunswick Corp., 288 F.3d 1359, 1366 (Fed. Cir. 2002).

Appellant respectfully submits that the same Merriam-Webster dictionary definition for the word "torus" was previously adopted by Appellant for use with this application in the Response to Office Action filed February 8, 2002 with no objection from the Examiner. (See Response to Office Action filed February 8, 2002, p. 4, line 20 – p. 5, line 2). Also, the embodiment of the invention shown in Figures 1 and 2 of the specification includes a torus-shaped compression spring. Thus, there is no question as to whether the specification supports the language of pending claim 15.

To support an anticipation rejection under 35 U.S.C. § 102 each and every element or limitation in the rejected claim must be disclosed in a single prior art reference used in the claim rejection.

As set forth above, Anderson does not disclose nor suggest a compression spring in the shape of a torus as defined by Appellant. The Examiner has not disputed Appellant's assertion that Anderson does not teach or suggest a compression spring in the shape of a torus wherein the word "torus" is defined as in the attached dictionary definition.

Instead, the Examiner has maintained the rejection of claim 15 based on a broader and vague interpretation of the term "torus" obtained from patent references not related to the present application. This is clearly improper. "Where an explicit definition is provided by the applicant for a term, that definition will control interpretation of the term as it is used in the claim." Toro Co. v. White Consolidated Industries, Inc., 53 USPQ2d 1065, 1069 (Fed. Cir. 1999) (See Also, MPEP § 2111.01 (I)). Absent some particular reason to do otherwise, the claim terms must be interpreted as would one of ordinary skill in the art of the relevant technology in light of the particular patent in suit. Medrad, Inc. v. MRI Devices Corp., 401 F.3d 1313 (C.A.Fed. Mar. 16, 2005). Further, it is improper to broaden the scope of the claimed invention by ignoring clear limitations in the claim language. Cardiac Pacemakers, Inc. v. St. Jude Medical, Inc., 296 F.3d 1106, 1113 (Fed. Cir. 2002).

Moreover, the multiple definitions for the word "torus" identified by the Examiner are inconsistent and therefore ambiguous when taken together. The definition adopted by the Examiner for the word "torus" is reproduced herein as follows:

"[t]he term "torus" wherein the cross section of the torus can take form of different shapes such as disclosed by Pees et al. (U.S. Patent No. 4,527,781), see col. 2, lines 56-59; Askew (U.S. Patent No. 6,412,586), see col. 4, lines 4-7); and Etnyre (U.S. Patent No. 5,941,351) recites "The piston head 170 is shown in Figs. 2 and 6 as being a generally thin, sheet-like member that has a torus shape similar to a washer (which has a rectangular cross section) see col. 10, lines 56-58."

(Advisory Action, ¶ 1, ll. 7-8).

The above-identified Pees and Etnyre citations set forth by the Examiner include two distinct shapes described using the terms "wide torus" and "torus" respectively. The citation identified by the Examiner in the Askew reference includes the term "toroidal" and does not even mention the word "torus". Accordingly, the Examiner has not identified anything that sets forth the ordinary and customary meaning of the word "torus" such that the dictionary definition identified by Appellant should not be utilized in construing the subject claims.

In a further attempt to avoid the present Appeal, Appellants representative Donald J. MacDonald in a telephone conference with the primary Patent Examiner Mariano Sy offered to amend claim 15 to include the dictionary definition adopted by the Appellant in the prosecution history. Thus, the proposed claim 15 would include "a least one compression spring in the shape of a torus positioned within the first housing bore, wherein said torus is a surface or solid shaped like a doughnut and formed by revolving a circle about a line in its plane without intersecting it." Still, the Examiner would not withdraw the section 102 rejection based on Anderson, even though admitting that Anderson does not teach or suggest a spring in the shape of a torus as defined by Appellant and clearly shown in FIGS. 1 and 2 thereof.

For at least the foregoing reasons, Anderson does not anticipate Appellant's claim 15 under 35 U.S.C. §102 (b) and therefore the Examiner's rejection of claim 15 should be reversed.

Claims 19, 20 and 24 each depend either directly or indirectly from and thereby incorporate the limitations of claim 15. Accordingly, for at least the reasons set forth above with respect to claim 15, claims 19, 20 and 24 are also not anticipated under 35 U.S.C. §102(b) by Anderson and should be allowed.

B. Claim 1 is not unpatentable under 35 U.S.C. §103(a) as obvious over Anderson in view of Platkiewicz, in view of Curtis and in view of Spencer.

To establish a prima facie case of obviousness for a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

With respect to the section 103 rejection of claim 1, Anderson is cited as the primary reference wherein the Examiner has allegedly identified all of the elements of claim 1 except for at least one slip lining positioned between said first housing exterior surface and a bore wall defining said second housing bore.

Similar to claim 15, claim 1 recites a compression spring having a torus shape. For at least the reasons set forth above with respect to claim 15, Anderson does not teach or suggest a compression spring having a torus shape as defined by Appellant. Accordingly, Anderson does not teach or suggest all of the limitations of claim 1 except for the slip lining. Therefore, the Examiner has not established that Anderson in view of Platkiewicz, in view of Curtis, and in view of Spencer, teach or suggest each and every element of claim 1.

Thus, for at least the above-identified reasons, claim 1 is not obvious under 35 U.S.C. § 103(a) over Anderson in view of Platkiewicz, in view of Curtis, and in view of Spencer, and the rejection of claim 1 should be withdrawn.

Claims 3, 5, 6, 8, 10-14, 17 and 23 depend either directly or indirectly from claim 1 and also recite additional limitations. Since claim 1 is not obvious over Anderson in view of Platkiewicz, in view of Curtis, and in view of Spencer for at least the above-identified reasons, dependent claims 3, 5, 6, 8, 10-14, 17 and 23 are also not obvious over Anderson in view of Platkiewicz, in view of Curtis, and in view of Spencer. Therefore, the rejection of claims 3, 5, 6, 8, 10-14, 17 and 23 under 35 U.S.C. § 103(a) should also be withdrawn.

Claims 21 and 22 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Anderson in view of Platkiewicz, in view of Curtis, and in view

Spencer. Claims 21 and 22 depend either directly or indirectly from claim 15 and also recite additional limitations.

With respect to the section 103 rejection of claims 21 and 22, Anderson is cited as the primary reference wherein the Examiner has allegedly identified all of the elements of claim 15. For at least the reasons set forth above with respect to claim 15, Anderson does not teach or suggest a compression spring having a torus shape as defined by Appellant. Thus, Anderson, nor the combination of Anderson in view of Platkiewicz, in view of Curtis, in view of Spencer, does not teach or suggest all of the limitations of claim 15.

Since claim 15 is not obvious over Anderson in view of Platkiewicz, in view of Curtis, and in view of Spencer for at least the above-identified reasons, dependent claims 21 and 22 are also not obvious over Anderson in view of Platkiewicz, in view of Curtis, and in view of Spencer. Therefore, the rejection of claims 21 and 22 under 35 U.S.C. § 103(a) should also be withdrawn.

VIII. Claims Appendix

Listing of current claims:

1. (Previously presented) A bearing pad assembly comprising:
 - a first housing having an exterior surface and defining a bore extending at least part-way through said first housing;
 - a first load bearing member coupled to said first housing, and defining an outwardly facing first abutment surface;
 - a second housing defining a bore of a shape similar to said exterior surface of said first housing and adapted to slideably receive said first housing therein;
 - a second load bearing member coupled to said second housing and defining an outwardly facing second abutment surface opposite to said first abutment surface;
 - at least one slip lining positioned between said first housing exterior surface and a bore wall defining said second housing bore; and
 - at least one compression spring positioned within said first housing bore, said compression spring comprising a solid resilient material having a torus shape.
2. (Cancelled)
3. (Previously presented) The assembly of claim 1 wherein the compression spring deforms non-linearly in response to a load imposed on at least one of the first and second abutment surfaces.
4. (Cancelled)

5. (Previously presented) The assembly of claim 1 wherein said solid resilient material is substantially an organic polymer.
6. (Original) The assembly of claim 5 wherein said organic polymer is substantially polyurethane.
7. (Cancelled)
8. (Previously presented) The assembly of claim 1 wherein said compression spring includes:
 - at least two compression springs; and
 - a plate positioned between said compression springs separating said compression springs from one another.
9. (Cancelled)
10. (Previously presented) The assembly of claim 1 wherein the slip lining has a coefficient of static friction less than that of the first housing.
11. (Previously presented) The assembly of claim 1 wherein the slip lining is attached to the first housing exterior surface.
12. (Previously presented) The assembly of claim 1 wherein a second slip lining is attached to the second housing bore wall.

13. (Previously presented) The assembly of claim 1 wherein the slip lining is made substantially of an organic polymer.
14. (Original) The assembly of claim 13 wherein the slip lining is made substantially of polypropylene.
15. (Previously presented) A bearing pad assembly comprising:
a first housing having a bore extending through said first housing;
a first load bearing member coupled to said first housing and defining an abutment surface opposite to said first housing;
a second housing having a bore extending through said second housing, adapted to telescopically receive said first housing;
a second load bearing member coupled to said second housing and defining an abutment surface opposite to said second housing; and
at least one compression spring in the shape of a torus positioned within said first housing bore.
16. (Cancelled)
17. (Previously presented) The assembly of claim 1 wherein the compression spring has a largest diameter slightly smaller than that of the first housing bore.
18. (Cancelled)

19. (Previously presented) The assembly of claim 15 further comprising two compression springs positioned within said first housing bore.
20. (Previously presented) The assembly of claim 19 further comprising a plate positioned between the springs, separating the springs from one another.
21. (Previously presented) The assembly of claim 15 further comprising a first slip lining attached to said first housing exterior surface.
22. (Previously presented) The assembly of claim 21 further comprising a second slip lining attached to the second housing bore wall.
23. (Previously presented) The assembly of claim 1 wherein said torus shaped compression spring defines an outside diameter minus an inside diameter equal to or greater than a height when positioned in the bearing pad assembly.
24. (Previously presented) The assembly of claim 15 wherein said torus shaped compression spring defines an outside diameter minus an inside diameter equal to or greater than a height when positioned in the bearing pad assembly.

IX. Evidence Appendix

Attached are copies of the following U.S. Patents entered by the Examiner in the Advisory Action dated February 8, 2005 and relied on by the Examiner as grounds of the rejection to be reviewed by the Board. (See Advisory Action, dated February 8, 2005, page 2, lines 6-12).

U.S. Patent No. 4,527,781 to Pees et al.

U.S. Patent No. 5,941,351 to Etnyre

U.S. Patent No. 6,412,586 to Askew

X. Related Proceedings Appendix

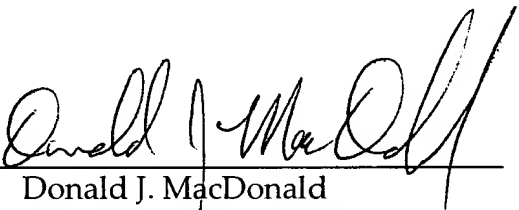
Attached is a copy of a Decision on Appeal dated June 22, 2004, previously rendered by the Board of Patent Appeals and Interferences with respect to the present application.

CONCLUSION

In view of the foregoing, it is respectfully submitted that claims 1, 3, 5, 6, 8, 10-15, 17, and 19-24 are allowable and the Examiner's rejections thereof should be reversed.

No fees are considered to be due with the filing of this Supplemental Appeal Brief; however, if it is determined that payment of a fee is required, please charge our Deposit Account No. 13-0235.

Respectfully submitted,

By 
Donald J. MacDonald
Registration No.: 42,823
Attorney for Appellants

McCORMICK, PAULDING & HUBER LLP
CityPlace II, 185 Asylum Street
Hartford, CT 06103-4102
Tel: (860) 549-5290
Fax: (860) 527-0464

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte RICHARD L. PALINKAS

Appeal No. 2004-1395
Application No. 09/407,053

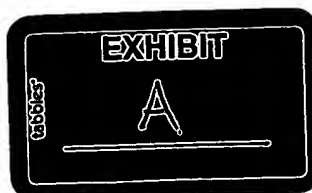
ON BRIEF

Before COHEN, NASE, and BAHR, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 3, 5 to 8, 10 to 15 and 17 to 22, which are all of the claims pending in this application.

We REVERSE.



Appeal No. 2004-1395
Application No. 09/407,053

Page 2

BACKGROUND

The appellant's invention relates generally to springs and is more specifically directed to devices that dampen lateral rolling motions that occur during the movement of railroad cars (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Magowan	136,079	Feb. 18, 1873
Platkiewicz et al. (Platkiewicz)	4,465,799	Aug. 14, 1984
Carlston	4,998,997	Mar. 12, 1991
Curtis et al. (Curtis)	5,036,774	Aug. 6, 1991
Spencer et al. (Spencer)	5,086,707	Feb. 11, 1992

Claims 15, 19 and 20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Carlston in view of Magowan.

Claims 1, 3, 5 to 8, 10 to 14, 17, 18, 21 and 22 stand rejected under 35 U.S.C. § 103 as being unpatentable over Carlston in view of Magowan in view of Platkiewicz and further in view of Curtis and Spencer.

Appeal No. 2004-1395
Application No. 09/407,053

Page 3

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the final rejection (Paper No. 18, mailed November 19, 2002) and the answer (Paper No. 23, mailed May 6, 2003) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 22, filed April 17, 2003) and reply brief (Paper No. 24, filed July 3, 2003) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 1, 3, 5 to 8, 10 to 15 and 17 to 22 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is

Appeal No. 2004-1395
Application No. 09/407,053

Page 4

established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention.

See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Claims 15, 19 and 20

Claim 15 reads as follows:

A bearing pad assembly comprising:
a first housing having a bore extending through said first housing;
a first load bearing member coupled to said first housing and defining an abutment surface opposite to said first housing;
a second housing having a bore extending through said second housing, adapted to telescopically receive said first housing;
a second load bearing member coupled to said second housing and defining an abutment surface opposite to said second housing; and
at least one compression spring in the shape of a toroid positioned within said first housing bore, the toroid having an outside diameter minus an inside diameter equal to or greater than a height when positioned in the bearing pad assembly.

Carlston's invention relates to railroad cars and particularly to articulated railroad cars and to side bearing units used therewith. A side bearing unit is attached to the bolster of each truck thereby regulating independent movement of the body of the car and impeding truck hunting. Side bearing units have been used to regulate movement between the body of a railroad car and the trucks for a substantial period of time.

Appeal No. 2004-1395
Application No. 09/407,053

Page 5

Carlston's side bearing unit 30 is shown in Figures 2, 4, 5 and 6. The side bearing unit 30 includes a round top cap 32, a housing 34 and first and second thermoplastic elastomeric springs 36 and 38. The generally round top cap 32 includes a top surface 40, a downwardly depending integrally formed side wall 46 and a bottom surface 48 having a centrally located integrally formed depending secondary solid stop 50 and a primary stop surface 52. A housing 34 includes a base portion 56, an integrally formed upwardly extending side wall 60 which includes a primary stop portion 62 and an integrally formed upwardly extending secondary stop 66 that cooperates with the depending secondary stop 50. The housing 34 fits within the round top cap 32 creating an internal void 68.

Carlston's first and second thermoplastic elastomeric springs 36 and 38 are situated within internal void 68 in a piggyback position. Both thermoplastic elastomeric springs are identical and by placing them in series, the available travel of the side bearing can be doubled and the spring rate cut in half. The two elastomeric springs are separated by a plate 75 and both are mechanically locked to the plate by pins 77, thus forming an elastomer spring assembly. Referring to Figure 7, it is apparent that the elastomeric spring is an open-ended hollow tube. The thermoplastic elastomer spring 36 is designed to fold and flex as it is subjected to a work cycle. Carlston teaches (column 4, lines 15-22) that

Appeal No. 2004-1395
Application No. 09/407,053

Page 6

the elastomeric spring is so designed so that throughout its total travel from free height, it is folding and flexing rather than compressing. The loaded area remains essentially the same throughout its total travel. This is accomplished by designing the pre-formed thermoplastic elastomeric spring so that the outside diameter minus the inside diameter is less than the solid height within the side bearing.

Magowan's invention relates to a spring for a railroad car. As shown in Figures 1-2, the spring includes a central cylindrical core A of India rubber, two surrounding rings B of India rubber having a circular cross-section, a box D surrounding the rings B and a follower C of corresponding configuration with the interior of the box so as to form an opposite bearing for the spring. Magowan teaches that his spring has a high degree of elasticity, great bearing strength and may be manufactured with great economy.

After the scope and content of the prior art are determined, the differences between the prior art and the claims at issue are to be ascertained. Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966).

Based on our analysis and review of Carlston and claim 15, it is our opinion that the only difference is the limitation that the toroid spring has an outside diameter minus an inside diameter equal to or greater than a height when positioned in the bearing pad assembly.

Appeal No. 2004-1395
Application No. 09/407,053

Page 7

In our view, the combined teachings of Carlston and Magowan would not have led one of ordinary skill in the art to have modified Carlston to arrive at the claimed invention for the reasons set forth by the appellant in the briefs. We fail to find sufficient motivation in the teachings of Magowan for one skilled in the art not to follow the specific teachings of Carlston that the elastomeric spring fold and flex rather than compress and that the outside diameter minus the inside diameter of the spring is less than the solid height of the spring. As such, we conclude that it would not have been obvious at the time the invention was made to a person of ordinary skill in the art from the combined teachings of Carlston and Magowan to have modified the toroid springs of Carlston to have an outside diameter minus an inside diameter equal to or greater than a height when positioned in the bearing pad assembly.¹

For the reasons set forth above, the decision of the examiner to reject claim 15, and claims 19 and 20 dependent thereon, under 35 U.S.C. § 103 is reversed.

Claims 1, 3, 5 to 8, 10 to 14, 17, 18, 21 and 22

We have reviewed the references to Platkiewicz, Curtis and Spencer additionally applied in the rejection of claims 1, 3, 5 to 8, 10 to 14, 17, 18, 21 and 22 but find

¹ The mere fact that the prior art could be modified in the manner suggested by the Examiner does not make such a modification obvious unless the prior art suggested the desirability of the modification. See In re Gordon, 773 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

Appeal No. 2004-1395
Application No. 09/407,053

Page 8

nothing therein which makes up for the deficiencies of Carlston and Magowan discussed above with respect to claim 15. Independent claim 1, the only other independent claim on appeal, contains the same limitations as claim 15 not suggested by the combined teachings of Carlston and Magowan. Accordingly, we cannot sustain the examiner's rejection of appealed claims 1, 3, 5 to 8, 10 to 14, 17, 18, 21 and 22 under 35 U.S.C. § 103.

Appeal No. 2004-1395
Application No. 09/407,053

Page 9

CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 3, 5 to 8, 10 to 15 and 17 to 22 under 35 U.S.C. § 103 is reversed.

REVERSED

IRWIN CHARLES COHEN
Administrative Patent Judge

JEFFREY V. NASE
Administrative Patent Judge

JENNIFER D. BAHR
Administrative Patent Judge

BOARD OF PATENT
APPEALS
AND
INTERFERENCES

Appeal No. 2004-1395
Application No. 09/407,053

Page 10

RAYMOND D. THOMPSON
UNIROYAL CHEMICAL COMPANY INC
WORLD HEADQUARTERS
MIDDLEBURY, CT 06749

JVN/jg